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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,441	09/08/2003	Simon Alan Jones	G&C 30566.256-US-U1	1424
55895	7590	02/21/2007	EXAMINER	
GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			LAY, MICHELLE K	
			ART UNIT	PAPER NUMBER
			2628	
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	02/21/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/657,441	JONES ET AL.
Examiner	Art Unit	
Michelle K. Lay	2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

WHEN REPLY IS DUE, FROM THE MAILING DATE OF THIS COMMUNICATION:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 15 January 2007.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) Claim(s) _____ is/are allowed.
6) Claim(s) 1-21 is/are rejected.
7) Claim(s) _____ is/are objected to.
8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 08 September 2003 is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
5) Notice of Informal Patent Application
6) Other: _____

DETAILED ACTION

Response to Amendment

The amendment filed 01/15/2007 has been entered and made of record. Claims 1-3, 7-9, 13-15, and 19-21 are pending.

Response to Arguments

Applicant's arguments filed 08/08/2006 have been fully considered but they are not persuasive in regards to claims 1-3, 7-9, 13-15, and 19-21.

The amendment to claim 1 has overcome the 35 USC §101 rejection made in the Non-Final office action filed 10/16/2006. However, in regards to claim 7, the 35 USC §101 rejection stands. Although claim 7's preamble states an apparatus (it does claim an invention within one of the statutory classes), the limitations of the claim are directed to an abstract idea, i.e., it is in reality seeking patent protection of the "computer drawing program", therefore claiming an invention that falls/covers/includes a judicial exception. Ergo, there is no practice application by physical transform, i.e., the program. The claim is in fact reciting limitations of the instructions/program and not limitations of the apparatus to produce a result.

Applicant argues the "location" as set forth in the pending claims differs from the "location" used in the prior art rejections (Hollingsworth, Matsushita, Felser). Examiner respectfully disagrees. Applicant determines the claimed "location" is an actual specified identified location for the object that is defined without moving or placing the object (*Applicant's remarks*, pg. 7). Furthermore, the location can be defined by moving

the location grip. However, claims 1, 7, and 13 do not recite the grip limitation that Applicant argues as the key limitation that allows the "computer drawing program" to define the "location" without moving the objects in the drawing program. Thus, in regards to Hollingsworth, the rules define how to place the object within the drawing without physically moving the object to its location, as claims 1, 7, and 13's limitations require.

Applicant argues that placing objects into a drawing is considered *moving*. Examiner respectfully disagrees. In this context, placing objects into a drawing is considered *inserting*.

In regards to claims 19-21, the placement subsystem of Hollingsworth manipulates the information retrieved from database subsystem by applying user-defined rules to determine the proper placement of the graphical objects on the graphical image [col. 4 lines 64-66]. The rules are in relation to the drawing in which the object will be placed in, i.e., the space.

In regards to claims 4, 10, and 16, Applicant argues Matsushita fails to provide support for the automatic door limitation. However, in the Non-Final office action filed 10/16/2006, Examiner rejected such limitations in view of Hollingsworth. The rules of Hollingsworth provide a means for defining rules for a text string to be drawn on the object. provides a means for automatically labeling a graphical object with text, such as with a number as claimed.

Claim Rejections - 35 USC § 101

Claims 7-12, and 20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 7 recites a system that solely calculates an algorithm. This is not directed to the type of subject matter eligible for patent protection. One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent "in practical effect would be a patent on the [abstract idea] itself." Benson, 409 at 71-72, 175 USPQ at 676; *cf. Diehr*, 450 U.S. at 187, 209 USPQ at 8. Whether or not the claimed invention is "a system with a program" or "a program" itself, the claimed invention covers an abstract idea. Application steps (i), (ii), (iii) and (iv) are merely considered as functional descriptive material, therefore claiming an invention that falls/covers/includes a judicial exception. Ergo, there is no practice application by physical transform, i.e., the program.

Claims 1-6, and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Although claim 1 does claim an invention within one of the statutory classes, the limitations of the claim are directed to an abstract idea; i.e., it is in reality seeking patent protection of the "computer drawing program", therefore claiming an invention that falls/covers/includes a judicial exception. Please see rationale regarding claims 7-12, and 20.

Claims 13-18, and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In regards to claim 13, paragraph [0023] of the disclosure recites that the "graphics program comprises logic and/or data

embodied in/or readable from a ... carrier or signal ...", which implicates that the claimed "program storage medium readable by a computer" is a "media, carrier or signal" and hence is deemed nonstatutory. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in §101.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-12, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regards to claim 7, it is unclear if the claims are claiming a method or a system since the preamble states an apparatus, however the limitations recite a method. Please see the reasoning of the 35 USC §101 rejection above.

Allowable Subject Matter

Claims 5, 11, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-3, 7-9, 13-15, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollingsworth et al. (5,444,836).

In regards to claims 1, 7, 13, 19-21 –

Hollingsworth discloses an apparatus and method for creating and applying flexible, user defined rules for placement of graphical objects in a computer aided drafting (CAD) application. The placement subsystem (100) and its relationship to other subsystems are shown in Fig. 1. Placement subsystem (100) communicates with database subsystem (102) over bidirectional communication link (110) to retrieve information and attributes associated with graphical objects to be placed on a graphical image. Database subsystem (102) may represent any database means capable of storing and retrieving information (claims 13, 21: storage medium readable by computer).

Placement subsystem (100) manipulates the information retrieved from database subsystem (102) by applying user-defined rules to determine the proper placement of the graphical objects on the graphical image (claims 1.c.i-ii., 7.b.iii.1-2., 13.c.i-ii., 19-21) [col. 4 lines 64-66]. Thus, the rules of Hollingsworth provides where the object should be placed without having to physically move the object to the location.

Placement subsystem (100) then communicates with drawing subsystem (104) over communication link (112) to instruct drawing subsystem (104) where to draw each graphical object on the graphical image [col. 4 lines 66-68]. Drawing subsystem (104) transforms information to graphical output device (106) over communication link (114) to create the desired graphical image (claims 1.a., 7.b.i., 13.a., 19-21). The resulting graphical image constructed by graphical output device (106) shows the graphical objects placed on the graphical image according to the user defined rules manipulated by placement subsystem (100) [col. 5 lines 1-8]. As shown in Fig. 2, these subsystems (100) (102) (104) may coexist on a common computer system (210) (claims 7, 20: a computer having memory) [col. 5 line 14]. The rule-processing component (200) represents the rule application (claim 7.b.) means for automatically reading and applying the placement rules defined by the user of the rule definition means [col. 5 lines 58-61]. Graphical objects may be lines, symbols, geometric shapes, text, or other constructs which are to be placed on the graphical image (claims 1.b., 7.b.ii., 13.b.) [col. 1 lines 24-26].

In regards to claims 2, 8, 14 –

Fig. 2 depicts additional detail of the components within placement subsystem (100). A user of placement subsystem (100) uses rule creation and modification component (202) to create a textual file specifying the user defined placement rules to be applied in placement of all graphical objects (claims, 2, 8, 14). The rule specification file contains a structured record for each set of rules to be applied to a particular class of graphical objects being placed [col. 5 lines 32-39]. As shown in Fig. 2, the placement subsystem (100) exists on a common computer system (210) (claim 8) [col. 5 line 14] and includes database subsystem (102) representing any database means capable of storing and retrieving information (claim 14).

In regards to claims 3, 9, 15 –

The rule-processing component (200) of Fig. 2 reads the rule specification file from storage device (204) to initiate the creation of graphical image on graphical output device (106). Each structured record read from storage device (204) includes a database query element to be applied by rule processing component (200) to database subsystem (102) [col. 5 lines 61-68]. The application of the query element to database subsystem (102) results in retrieval of zero or more information records. Each information record retrieved by the application of the query element to database subsystem (102) contains information regarding nominal placement of a graphical object to be placed on the graphical image (claims 3, 9, 15) [col. 6 lines 1-7]. As shown in Fig. 2, these subsystems (100) (102) (104) may coexist on a common computer

system (210) (claim 9) [col. 5 line 14] and includes database subsystem (102) representing any database means capable of storing and retrieving information (claim 15).

2. Claims 4, 10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hollingsworth et al. (5,444,836) in view of Matsushita et al. (6,049,340).

Hollingsworth teaches the limitations of claims 4, 10, 16 with the exception of disclosing the object as a door. However, Matsushita discloses a computer aided design (CAD) system in which the user selecting generates graphic drawings and placing figures representing objects such as walls and doors on a screen.

In combination with the rationale of claims 1, 7, and 13 respectfully, Hollingsworth further teaches the ability to place text on the graphical image. The text blocks specify the TS text string drawing keyword statement to invoke the text drawing features of placement subsystem (100) in drawing the placeable text block on the graphical image (claim 4: door number) [col. 21 lines 17-23]. Furthermore, TS is a high-level keyword statement used to specify that a text string is to be drawn to represent the placeable object on the graphical image [Hollingsworth: col. 16 lines 45-47]. This keyword is part of the user-defined rules. Thusly, by defining rules for a text string to be drawn on the object provides a means for automatically labeling a graphical object with text, such as with a number as claimed.

As shown in Fig. 2, the CAD system of Matsushita is a multi-window CAD system (claim 10: computer system) and runs a CAD program (claim 16: executable

instructions) that is used to generate graphic drawings of buildings [col. 3 lines 63-65]. Referring to Fig. 1, a command-selecting unit (1) selects a command to place a figure at a desired position with desired shape [col. 3 lines 40-41]. This figure may be a door as shown in Figs. 7, 8, 9, and 10 (claims: 4, 10, 16: object as a door) [col. 8 line 15].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the generation of graphic drawings of buildings of Matsushita with the automatic placement of Hollingsworth with Matsushita because the automatic placement reduces the burden on the user of manually applying complex drafting rules in creating or modifying graphical images [Hollingsworth: col. 3 lines 64-66] within computer aided design systems. As Hollingsworth determines, graphical objects may be lines, symbols, geometric shapes, text, or other constructs which are to be placed on the graphical image [Hollingsworth: col. 1 lines 24-26]. Thus, doors may be included within these graphical objects.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle K. Lay whose telephone number is (571) 272-7661. The examiner can normally be reached on Monday through Thursday from 7:30am to 5:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee M. Tung, can be reached at (571) 272-7794. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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